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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,808	07/22/2003	Raymond G. Goodwin	03260-0148-04000	5275

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EXAMINER	
BRANNOCK, MICHAEL T	
ART UNIT	**PAPER NUMBER**
1649	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/623,808	GOODWIN ET AL.	
	Examiner	Art Unit	
	Michael Brannock	1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-47* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, 28, drawn to 41BB-ligand polynucleotides, methods of producing a polypeptide, classified in class 435, subclass 69.1.

II. Claims 17-25, drawn to 41BB-ligand polypeptides, classified in class 530, subclass 350.

III. Claims 26 and 27, drawn to 41BB-ligand antibodies, classified in class 530, subclass 388.22.

IV. Claims 29-37, 47, drawn to 41BB polynucleotides, methods of producing a polypeptide, classified in class 435, subclass 69.1.

V. Claims 38-44, drawn to 41BB polypeptides, classified in class 530, subclass 350.

VI. Claims 45, 46, drawn to 41BB antibodies, classified in class 530, subclass 388.22.

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products appear to constitute patentably distinct inventions for the following reasons: Groups I-VI are directed to products that are distinct both physically and functionally, and are not required one for the other, and are therefore patentably distinct. Further, the protein of Groups II and V can be prepared by processes which are materially

different from recombinant DNA expression of Groups I and IV, such as by chemical synthesis, or by isolation and purification from natural sources. Additionally, the DNA of Groups I and IV can be used other than to make the protein of Groups II and V, such in gene therapy or as a probe in nucleic acid hybridization assays. The protein of Groups II and V can be used in materially different methods other than to make the antibody of Groups III and VI, such as in therapeutic or diagnostic methods (e.g., in screening). Additionally, although the antibody of Groups III and VI can be used to obtain the DNA of Groups I and IV, it can also be used in materially different methods, such as in various diagnostic (e.g., in as a probe in immunoassays or immunochromatography), or therapeutic methods.

Inventions I and IV are directed to distinct products and methods, in the former case DNA encoding 4-1BB-ligand and in the latter case that encoding 4-1BB, the receptor for 4-1BB-ligand. These inventions are considered to be distinct because nucleic acid molecules encoding the receptor and the ligand are distinct products neither of which is required for the manufacture or use of the other. Likewise the polypeptides of II and V are distinct from each other; although the ligand and receptor for a cognate pair in vivo, each is capable of separate uses, for example as distinct diagnostic agents or for the production of patentably distinct antibodies of Groups III and VI which are not physically or functionally related to each other in terms of the antigen to which they bind.

Therefore, because these inventions are distinct for the reasons given above and because a search and examination of all the groups in one patent application would result in an undue burden, since the searches for the groups are not co-extensive, the classification is different, and the subject matter is divergent, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1649.Please note the new central fax number for official correspondence below:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (571) 272-0869. The examiner can normally be reached on Mondays through Fridays from 10:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, Ph.D., can be reached at (571) 272-0867. Official papers filed by fax should be directed to **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB

June 12, 2006

JANET L. ANDRES
SUPERVISORY PATENT EXAMINER